

REMARKS

Claims 1-10 and 14-17 are pending in this application.

I. Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claim 17 under the written description requirement of 35 U.S.C. §112, first paragraph. Applicant respectfully traverses the rejection.

To provide written description for a claim, the specification as originally filed must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventors were in possession of the invention as claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. Specifically, the Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in the specification a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

The specification as originally filed meets the above requirements. The specification, at least at page 15, Example 2, for example, supports claim 17. This portion of the specification recites, "As described for aldehyde A1, 42.8 g of formaldehyde (37% in water, methanol-free), 38.0 g of isobutyraldehyde, 150.0 g of stearic acid and 1.0 g of 4-toluenesulfonic acid were reacted with the separation of around 37 ml of water." (Emphasis added). Applicant respectfully asserts that one of ordinary skill in the art would have recognized that preparing an aldehyde with stearic acid, which contains 17 carbon atoms, would result in an aldehyde of the formula B where R¹ is a linear or branched alkyl chain having 17 carbon atoms formed from the stearic acid. Therefore, one of ordinary skill in the art would have recognized that the

specification as originally filed supports the lower limit (17) of the carbons in the alkyl chain as recited in claim 17. Further, the Office Action, on page 2, recognizes that the claims, as originally filed, support the upper limit of the carbons (30) in the alkyl chain as recited in claim 17.

Thus, it is respectfully submitted that claim 17 meets the written description requirement of 35 U.S.C. §112, first paragraph. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejections Under 35 U.S.C. §103

The Office action rejects claims 1-6 and 17 under 35 U.S.C. §103(a) over U.S. Patent No. 4,853,454 to Merger et al. ("Merger") in view of U.S. Patent No. 5,010,161 to Aoki et al. ("Aoki"); rejects claim 7 under 35 U.S.C. §103(a) over Merger in view of Aoki; rejects claims 14 and 16 under 35 U.S.C. §103(a) over Merger in view of Aoki; rejects claims 8 and 9 under 35 U.S.C. §103(a) over Merger in view of Aoki and further in view of U.S. Patent No. 3,935,274 to Jacobsen et al. ("Jacobsen"); rejects claim 10 over Merger in view of Aoki and further in view of U.S. Patent No. 3,835,191 to Wagner et al. ("Wagner"); and rejects claim 15 over Merger in view of Aoki and further in view of JP 07025976 ("JP '976"). Applicant respectfully traverses the rejections. Because the rejections are related, they are addressed together herein.

The Office Action asserts that Merger discloses a polyaldimine that is obtainable from at least one polyamine having aliphatic primary amino groups and at least one aldehyde. However, the Office Action, on page 3, acknowledges that Merger does not disclose an aldehyde having the claimed formula. Therefore, the Office Action combines the disclosure of Merger with the disclosure of Aoki. The Office Action asserts that Merger and Aoki are combinable because they are concerned with polyaldimine compositions, and that Aoki suggests the aldehyde disclosed therein is a functional equivalent of the aldehyde disclosed in

Merger. However, Merger and Aoki, individually or in combination, fail to teach or suggest each and every feature of claim 1.

Merger discloses that R¹ and R² are alkyl groups with 1 to 6 carbons and that R³ and R⁴ are chains with from 1 to 10 carbons. See Merger, col. 3, line 59 - col. 4, line 9. Further, Aoki discloses an aldehyde having a long chain where R⁶ contains 16 or less carbon atoms. See Aoki, col. 3, lines 34-35 (emphasis added). Aoki also discloses that R⁶ is preferred to be a methyl group, ethyl group, propyl group, etc. See Aoki, col. 4, lines 57-58. Further, both Merger and Aoki disclose that it is preferable to utilize chains with less than the maximum amount of carbons disclosed in each reference (i.e., less than 6 or 10 in Merger and less than 16 in Aoki). Thus, neither Merger nor Aoki provide any reason or rationale for one of ordinary skill in the art to have utilized the maximum amount of carbons taught in either reference. Therefore, while Aoki discloses that the aldehyde may have a long chain containing up to 16 carbon atoms, neither Merger nor Aoki provides any reason or rationale that would have motivated one of ordinary skill in the art to have modified the aldehyde to specifically have a carbon chain above the maximum disclosed by Merger and near the maximum disclosed by Aoki, when both Merger and Aoki disclose that it is preferred to use chains with less carbons. Additionally, Merger and Aoki, individually or in combination, fail to disclose any benefit of using the long-chained carbons as claimed.

Also, the claimed invention is produced to reduce the odor of the aldehyde and aldimines. Specification, page 4, lines 23-25. Neither Merger nor Aoki teach or suggest this or any other rationale to combine the disclosure of Merger with the disclosure of Aoki to yield the claimed invention.

Furthermore, Aoki does not disclose the use of its aldehyde with aliphatic amino groups as required by claim 1. Aoki discloses the use of an aldehyde with aromatic amino groups. Therefore, neither Merger nor Aoki provides any reason or rationale to support that it

would have been obvious to one of ordinary skill in the art that the aldehyde disclosed in Aoki, for use with aromatic amino groups, would yield the same results if it were to be used with aliphatic amino groups, as disclosed in Merger. Aromatic amines are highly toxic and the amines, as well as the aldimines, formed with aromatic amino groups are solids, which need to be dissolved in a solvent or a diol when formulating a sealant. See Aoki, col. 25 - col. 28 (Examples 12-15). However, the aldimines of the claimed invention are liquids at room temperature. See, specification, paragraph [0042] and examples 7-13. Finally, aldimines based on the aromatic amines of Aoki are only used in practice in combination with aromatic polyisocyanates because of their reactivity, which is shown in examples 12-15 of Aoki. Therefore, Merger and Aoki, individually or in combination, fail to teach, suggest or provide a reason or rationale that would have led one of ordinary skill in the art to modify the references to achieve the claimed invention.

Further, the other three references (Jacobsen, Wagner and JP '976) are not applied to address the discrepancies of Merger and Aoki as to claim 1. These references are applied by the Office Action to disclose various features of defendant claims 2-10 and 14-17. Therefore, Merger, Aoki, Jacobsen, Wagner and JP '976, individually or in combination, fail to teach or suggest each and every feature of claim 1.

For at least the reasons stated above, claim 1 would not have been rendered obvious by Merger, Aoki, Jacobsen, Wagner and JP '976, individually or in combination. Claims 2-10 and 14-17 variously depend from claim 1 and, thus, also would not have been rendered obvious by Merger, Aoki, Jacobsen, Wagner and JP '976, individually or in combination. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Notice of Appeal and Petition for Extension of Time

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